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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/540,632

06/23/2005

Yukimitsu Suda

IWI-16057

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

11/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,632

Applicant(s)

SUDA ET AL.

Examiner

Danielle Sullivan

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/21/2005 and 03/02/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: [0061] needs to be rewritten with proper justification so words are not abruptly disjointed.

Appropriate correction is required.

Claim Objections

Claim 1 is objected to because of the following informalities: "a complex powder that the surface" should be "a complex powder where the surface". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term " a complex powder that the surface of lipophilic base powder is covered with zinc oxide" in claims 1 and 12 is unclear. One having ordinary skill would not be able to discern what applicant is seeking to claim. If statement were to read " a complex powder where the surface of lipophilic base powder is covered with zinc oxide" the claim would be definite, because one having ordinary skill would be able to understand that the powder is covered with zinc oxide and not just the surface of the

complex powder. For purpose of search the Examiner is assuming applicant is claim a complex powder where the powder is combined with zinc oxide.

The term "zeta-potential of said lipophilic base powder is negative value at pH on skin" is not definite. It is not understood how zeta-potential correlates to "pH on skin". The fact that zeta-potential is a theoretical idea cannot establish definiteness since it is not fixed and varies according to conditions. Therefore, where components of the composition (an organic powder comprising an organic powder covered with zinc oxide are found in the prior art as being in a composition the claims will be taken as inherently teaching the claimed zeta-potential.

The term "covering rate" in claim 2 is a relative term which renders the claim indefinite. The term "covering rate" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how the covering rate is measured because the surface area is not clearly defined.

The term "swelled in the condition of dispersing in oil" in claim 2 is a relative term which renders the claim indefinite. The term "swelled in the condition of dispersing in oil" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear how the powder becomes swelled in the condition. It is unclear if applicant is just seeking a way of saying that the powder is an emulsion when combined with the oil. If stated to read that the powder forms an emulsion in oil the claimed invention would be definite.

Claims 10 and 11 provides for the use of the composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10 and 11 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-12 rejected under 35 U.S.C. 102(b) as being anticipated by Nakane et al. (US 5,182,103).

Applicant claims a composition for skin comprising, a complex powder where the surface of lipophilic base powder (and organic powder, preferably silicone resin, silicone rubber, silicone resin-covering-silicone rubber, polyamide, polymethyl methacrylate or

ethyl carbamate) is combined with zinc oxide and an oil component (preferably silicone oil). The complex powder and oil component forms an emulsion and the powder is 1 to 50% by weight the composition. The composition is then use as a skin treatment.

Nakane et al. teach a core powder coated with any desired organic or inorganic powder with an average size of 0.1 to 50 μm by mixing. The powders include organic powders of polyamide resins, natural rubber and synthetic rubber and zinc white (oxide) (column 3). The coated powder is preferably 0.1 to 100% by weight the composition (column 4). The oil component comprises silicone oil (column 6, line 1). The composition is used as a skin treatment in cosmetics. The fact that the composition is an emulsion is now specifically taught but nevertheless an emulsion would be an inherent property of the composition. Depending on the makeup of the composition (concentration, etc.) the fact that all component listed are anticipated by Nakane et al. the composition would be the same since the % by weight falls within the range of Nakane et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoneyama et al. (US 5015469), Suzuki et al. (US 5061481 and US 5219560), Herstein et al. (US 5118496), Nagatani et al. (5578311), Kishida et al. (5928658), Ogawa et al (6080430), Yoshida et al. (US 6649179) and Yokoyama et al.(US 20050181067).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Danielle Sullivan
Patent Examiner


SHIGENOBU
PRIMARY EXAMINER
